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T-D

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/269,771 | 05/17/00 | WENDLAND | N 4080-29PUS |

IM52/0718

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| EXAMINER | |
|---|---|
| PRATT, C | |
| ART UNIT | PAPER NUMBER |
| 1771 | 16 |

DATE MAILED: 07/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/269,771 | WENDLAND, NIELS | |
| | Examiner | Art Unit | |
| | Christopher C. Pratt | 1771 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *7-10 and 12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendments and accompanying remarks filed 5/29/01 have been entered and carefully considered. Applicant's amendment is found to overcome the 112 rejections over the phrase "raised points." Despite this advance, the amendments are not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

### *Specification*

2. The amendment filed 5/29/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: On page 2 starting on line 15 applicant has amended the specification to include the generic names of a several different hot melt compositions in response to the examiner's previous objection to the use of trademarks. However, the trademarks used by applicant appear only to disclose the generic compositions of polyolefins, polyesters, and polypropylene. Applicant's originally filed specification does not appear to have disclosed the use of polyamides, EVA polymers, polyurethane polymers, or "other adhesives."

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 7-10 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's originally filed specification does not disclose a "woven" fabric. Applicant has stated that the international-phase application contains a word that translates into "woven fabric." The mere presence of this word, however, is insufficient to overcome a new matter rejection. Applicant is required to submit a certified translation of the international phase application so that the context in which this phrase is used may be determined.

Applicant's specification is found deficient because it does not teach what amounts and viscosities of an adhesive will prevent the adhesive from penetrating the fabric.

Applicant's specification is also deficient because it does not teach the structure of a fabric, which resists penetration, by an adhesive.

5. Claims 7-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "long-term adhesive" in line 8. There is insufficient antecedent basis for this limitation in the claim.

This phrase is indefinite, as noted in the last two office actions. This particular rejection could be overcome by replacing this phrase with the term permanent throughout the claims.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Deeb et al (5985775).

Deeb is concerned with the creation of an adhesive woven fabric (col. 9, lines 30-31). Deeb teaches that said woven fabric has a hot melt thermoplastic composition applied to one side thereof without penetrating the fabric to contaminate the second side (col. 8, lines 35-40). Deeb teaches said woven fabric to be composed of glass fibers (col. 6, lines 15-17). While it is not the preferred process, Deeb teaches that the polymer layer can be applied to the fabric by platen pressing, which results in a discontinuous polymer layer (col. 9, lines 30-35). Deeb teaches the use of thermoplastic compositions anticipating applicant's claimed hot melt compositions (col. 6, lines 40 and 50).

The examiner notes that, while Deeb is not using said polymer composition as an adhesive, that this function is merely an intended use of the composition and Deeb's hot melt polymer composition has the ability to act as an adhesive. The examiner further notes, as set forth in the last action, that applicant's claims do not preclude that said composition is present in areas other than the crossover points of the warp and weft strands. It is the examiner's position that this rejection could be overcome and place the application in better condition for allowance if applicant limited the claims to specify that the adhesive is present only on the crossover points of the warp and weft strands.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deeb et al (5985775).

With respect to claim 12, the examiner takes official notice that release films are extremely common and well known in the art of tapes and various adhesives. As such it would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize a release liner with the tape of Deeb. Such a combination would have been motivated by the desire to increase the ease of storing and transporting said tape and to prevent contamination of the resin layer.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt
July 16, 2001

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700